



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
|-----------------|-------------|----------------------|---------------------|------------------|

10/527,446

03/11/2005

Hidekazu Hoshino

123156

2172

25944

7590

08/05/2008

OLIFF & BERRIDGE, PLC

P.O. BOX 320850

ALEXANDRIA, VA 22320-4850

EXAMINER

SANDERS, STEPHEN

ART UNIT

PAPER NUMBER

2139

MAIL DATE

DELIVERY MODE

08/05/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|--------------------------------------|---------------------------------------|--|
| Office Action Summary | Application No. 10/527,446 | Applicant(s) HOSHINO ET AL. | |
| | Examiner STEPHEN SANDERS | Art Unit 2139 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 March 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 17-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 17-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>See Continuation Sheet</u> . | 6) <input type="checkbox"/> Other: _____ |

Continuation of Attachment(s) 3). Information Disclosure Statement(s) (PTO/SB/08), Paper No(s)/Mail Date :Mar. 11, 2005; Mar. 27, 2006; Mar. 22, 2007; May 10, 2007; Aug. 28, 2007; Feb. 27, 2008.

DETAILED ACTION

This is in response to Application/Control Number: 10/527446 filed on March 28, 2005 in which claims 17-31 are presented for examination.

Status of Claims:

Claims 17-31 are pending, in which claim 17 is in independent form. Claims 17, 18, and 21-31 are rejected under 35 U.S.C. 102(e). Claims 19, and 20 are rejected under 35 U.S.C. 103(a).

Claim Rejections - 35 USC § 102

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

1. Claims 17, 18, and 21-31 are rejected under 35 U.S.C. 102(e) as being anticipated by Uyama et al Patent Number RE38,321; Date of Reissued Patent: Nov. 18, 2003; Filing Date: May 14, 1999; hereinafter Uyama.

As to claim 17, the following is taught: "A discrimination medium for determining authenticity of an object by providing an optically discriminating mark on the object (Uyama: Abstract; column 2, lines 37-40), the medium comprising: a multilayer thin film having light selectivity of reflecting characteristics (Uyama: column 1, lines 10-14; column 2, lines 41-44) depending on a viewing angle (Uyama: Abstract; column 6, lines 34-43), and a support body (Uyama: column 2, lines 45-67) where the multilayer thin film fixed or a masking sheet fixed to a surface of the multilayer thin film for masking a part of the surface (Uyama: column 3, lines 1-21)".

As to claim 18, the following is taught: "The discrimination medium according to claim 17, wherein a portion is formed by printing or foil transfer, and the portion exhibits a color equivalent to the color of the medium which further comprises the multilayer thin film viewed from a specific direction (Uyama: column 4, lines 30-35; column 11, lines 48-67)".

As to claim 21, the following is taught: "The discrimination medium according to claim 17, wherein the multilayer thin film is cut into strips, small chips, or specific patterns, and the multilayer thin film is transcribed on a surface of the support body (Uyama: column 3, lines 1-62)".

As to claim 22, the following is taught: "The discriminating medium according to claim 17, wherein a hologram processing or a press processing is made to the multilayer thin film (Uyama: column 12, lines 12-30; column 12, lines 31-49)".

As to claim 23, the following is taught: "The discrimination medium for discriminating according to claim 17, wherein the discrimination medium has an adhesive layer to adhere the medium to the object, and the adhesive layer includes a pigment or dye having a color which may be black (Uyama: Abstract; column 5, lines 28-54; column 18, lines 32-43)".

As to claim 24, the following is taught: "The discrimination medium according to claim 17, the surface of the discrimination medium facing the object is printed which may be black (Uyama: column 22, lines 1-19)".

As to claim 25, the following is taught: "The discrimination medium according to claim 23, wherein a fluorescent material layer or a light accumulating material layer is held between a part of the discrimination medium and a part of the adhesive layer or between a part of the discrimination medium and a part of the printed layer (Uyama: column 38, lines 34-45)".

As to claim 26, the following is taught: "The discrimination medium according to claim 17, the medium further comprises: a slit partially formed in the discrimination medium (Uyama: column 9, lines 10-46; column 10, lines 7-9)".

As to claim 27, the following is taught: "The discrimination medium according to claim 17, the medium further comprises: a first multilayer thin film, a second multilayer thin film, and an optical absorption layer held between the first multilayer thin film and the second multilayer thin film (Uyama: column 17, lines 38-65)".

As to claim 28, the following is taught: "The discrimination medium according to claim 27, wherein both sides of the optical absorption layer have light selectivity of

Art Unit: 2139

reflecting characteristics depending on a viewing angle (Uyama: column 35, line 54 to column 36, line 9)".

As to claim 29, the following is taught: "The discrimination medium according to claim 22, wherein the multilayer thin film includes a stamped layer for forming at least one of a hologram and an embossment (Uyama: column 1, lines 43-55; column 1 64 to column 2, line 8)".

As to claim 30, the following is taught: "The discrimination medium according to claim 29, wherein the stamped layer is made from a material selected from thermosetting resins, ionization radiation hardening resin, and ultraviolet ray hardening resin (Uyama: column 5, lines 55-67; column 17, lines 17-31)".

As to claim 31, the following is taught: "The medium for discriminating according to claim 17, wherein the multilayer thin film is obtained by stacking thin films multiple and drawing the stacked films (Uyama: column 21, lines 12-39)".

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Uyama as applied to claim 17 above, and in view of Kuntz et al (Patent Number 6,641,874; hereinafter Kuntz), and further in view of Phillips et al (Patent Number 5,005,719; hereinafter Phillips).

As to claim 19, the following is taught: “The discrimination medium according to claim 17 is taught by Uyama (see above regarding claim 17), however Uyama fails to teach the cutting and shaping of the multilayer thin film. However in view of Kuntz's teaching of “wherein the multilayer thin film is cut into strips or fibers, the multilayer thin film is held between the support body divided into two layers (Kuntz: column 2, 19-25)”, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to tailor the shape and form of the multilayer thin film. Although this use is not recited by Uyama, one would be motivated to use this technique to expand the use of multilayer thin film in the area of identification and authentication.

Additionally, as to claim 19, the following is taught: “The discrimination medium according to claim 17 is taught by Uyama (see above regarding claim 17), however Uyama fails to teach the use of an opening in a support body containing the multilayer film in order to establish light ray access to the film. However in view of Phillips's teaching of “one or two layers of the support body have an opening to allow the multilayer thin film to be seen (Phillips: column 6, lines 34-52)”, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to add another configuration for access to the multilayer thin film. Although this use is not

Art Unit: 2139

recited by Uyama, one would be motivated to use this technique to expand the use of multilayer thin film in the area of identification and authentication.

4. Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Uyama as applied to claim 17 above, and in view of Kuntz et al (Patent Number 6,641,874; hereinafter Kuntz).

As to claim 20, the following is taught: “The discrimination medium” according to claim 17 is taught by Uyama (see above regarding claim 17), however Uyama fails to teach mixing pieces of the discrimination medium into a support body. However in view of Kuntz’s teaching of “wherein the multilayer thin film is cut into strips, fibers, or small chips, the support body is made of paper, and the multilayer thin film is mixed to the support body when the support body was made (Kuntz: column 4, lines 35-45; column 5, 24-29; column 6, lines 16-21)”, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to tailor the shape and form of the multilayer thin film. Although this use is not recited by Uyama, one would be motivated to use this technique to expand the use of multilayer thin film in the area of identification and authentication.

Conclusion

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to

STEPHEN SANDERS whose telephone number is (571)270-5308. The examiner can normally be reached on M - F; 7:30a.m. - 5:00p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kristine L. Kincaid can be reached on 571-272-4063. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Stephen Sanders/
Examiner, Art Unit 2139

/Krisitne Kincaid/
Supervisory Patent Examiner, Art
Unit 2139